

Application Serial No. 09/932,510
Response to April 9, 2004 OA

IS11-002

REMARKS

Claims 1-16 remain in the application. Reconsideration of the application in view of the amendments and the remarks to follow is requested.

Dependent claims 4-7 and 12-15 stand rejected under 35 U.S.C. §112, second paragraph, as not being supported by the disclosure. The Examiner states the respective dependent claims include language that is directed to alleged third and fourth embodiments of Applicant's invention, and that independent claims 1 and 9, from which the dependent claims depend, allegedly include language that is directed to inconsistent alleged first and second embodiments of Applicant's invention (pg. 2 of paper no. 0404). However, the four embodiments relied upon by the Examiner are not Applicant's embodiments. The Examiner refers to four embodiments discussed in paragraphs [0004] and [0005] of Applicant's disclosure (pg. 2 of paper no. 0404) which are directed to related art embodiments under the heading of "Description of the Related Art" (which include paragraphs [0003] to [0012]). That is, the Examiner is referring to embodiments of the related art, not embodiments of Applicant's invention. Consequently, respectfully, since the Examiner has confused embodiments of the related art as being embodiments of Applicant's disclosure, the Examiner's argument for the Examiner's §112, second paragraph rejection against claims 4-7 and 12-15 does not exist. The §112 rejection is improper and should be

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withdrawn. Applicant respectfully requests withdrawal of the rejection in the next office action.

No other rejections are presented against claims 4-7 and 12-15, and therefore, such claims are allowable.

Claims 1-3, 8-11 and 16 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Tsikos (4,507,557) in view of Ogawa (6,100,538).

The obviousness rejection fails for at least the reason that the alleged teaching of Ogawa for which the Examiner relies to base his argument for obviousness does not exist. The Examiner tacitly admits that Tsikos fails to teach a position pointing device having a light emitting means as recited positively recited in independent claims 1 and 9, and relies on Ogawa to provide the deficiency in teachings (pg. 5 of paper no. 0404). The Examiner states that Ogawa shows that it is known in the art that a light-emitting stylus can be used in the arrangement of the Tsikos system of using a shadow-producing object (pg. 5 of paper no. 0404). Respectfully, Ogawa does not provide any teachings to a system of using a shadow-producing object, and therefore, Ogawa could not possibly teach a light-emitting stylus can used in a system of using a shadow-producing object. In fact, an electronic search of Ogawa for "shadow" reveals the word is never used in the document. Accordingly, the alleged teachings of Ogawa for which the Examiner relies to make his obviousness argument does

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not exist, and therefore, the obviousness rejection is inappropriate and should be withdrawn. For at least reason, claims 1-3, 8-11 and 16 are allowable.

Moreover, the motivational rationale presented is inappropriate for several reasons, and therefore, since a proper obviousness rejection requires a proper motivation rationale, the obviousness rejection fails. The Examiner states it would be obvious to modify the Tsikos invention to use a light emitting stylus as allegedly taught by Ogawa "because it is a known alternative arrangement" (pg. 5 of paper no. 0404). Respectfully, the Examiner's alleged motivational rationale is devoid of any desirability for the modification of the Tsikos invention as is required for a proper obviousness rejection. The Federal Circuit has held that the mere fact that references can be combined or modified does not render the resultant combination obvious **unless the prior art also suggests the desirability of the combination**. MPEP §2143.01 (8th edition) *citing In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990) (emphasis added). Although a prior art device "may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so". 916 F.2d at 682, 16 USPQ2d at 1432; MPEP §2143.01; See also *In re Finch*, 972 F.2d, 1260, 23 USPQ2d, 1780 (Fed. Cir. 1992). Stating an alleged motivation rationale as "It is a known alternative arrangement" is completely avoiding the required argument to "the desirability of the combination" pursuant to the above authority. That is, the Examiner is merely stating that the

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references can be combined or modified which is the essence of "alternative arrangement" argument without providing the desirability of using the alternative arrangement for the Tsikos invention. Since the Examiner has presented an alleged motivational rationale contrary to Federal Circuit authority, the obviousness rejection must fail. For this additional reason, claims 1-3, 8-11 and 16 are allowable.

Additionally, the Examiner is respectfully reminded that if the proposed modification or combination of the prior art would change the principal of operation in the prior art invention being modified, then the teachings of the reference are not sufficient to render the claims *prima facie* obvious. MPEP §2143.01 (8th Edition) *citing to In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959). The court in *In re Ratti* reversed a rejection holding the "suggested combination of references would require substantial reconstruction and redesign of elements shown in the [primary reference] as well as a change in the basic principle under which the [primary reference] construction was designed to operate" 270 F.2d at 813, 123 USPQ at 352. The Examiner states it would be obvious to modify the Tsikos invention to use a light emitting stylus as allegedly taught by Ogawa "because it is a known alternative arrangement" (pg. 5 of paper no. 0404). However, using a light emitting stylus of Ogawa is a completely different principle of operation relative using the shadow-producing system of Tsikos. Modifying the Tsikos invention in this matter to change the principle of

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operation of the Tsikos is an improper modification, pursuant to the above Federal Circuit authority. For this additional reason, the obviousness rejection is inappropriate and should be withdrawn. Claims 1-3, 8-11 and 16 are allowable.

This application is now believed to be in immediate condition for allowance, and action to that end is respectfully requested. If the Examiner's next anticipated action is to be anything other than a Notice of Allowance, the undersigned respectfully requests a telephone interview prior to issuance of any such subsequent action.

Respectfully submitted,

Dated: 9-22-04By: 

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